

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

REC'D 13 SEP 2005
WIPO PCT

Applicant's or agent's file reference 63207A	FOR FURTHER ACTION See Form PCT/APEA/416	
International application No. PCT/US2004/021508	International filing date (day/month/year) 02.07.2004	Priority date (day/month/year) 08.07.2003
International Patent Classification (IPC) or national classification and IPC B29C37/00, B29C45/37, B29C33/42, G11B23/38		
Applicant DOW GLOBAL TECHNOLOGIES INC.		
<p>1. This report is the International preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of sheets, as follows:</p> <ul style="list-style-type: none"> <input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions). <input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box. <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)), containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>		
<p>4. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> <input checked="" type="checkbox"/> Box No. I Basis of the opinion <input type="checkbox"/> Box No. II Priority <input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability <input type="checkbox"/> Box No. IV Lack of unity of invention <input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement <input type="checkbox"/> Box No. VI Certain documents cited <input checked="" type="checkbox"/> Box No. VII Certain defects in the international application <input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application 		
Date of submission of the demand 14.01.2005	Date of completion of this report 13.09.2005	
Name and mailing address of the international preliminary examining authority: European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Mathey, X Telephone No. +31 70 340- 2606 	

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Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
 - This report is based on translations from the original language into the following language, which is the language of a translation furnished for the purposes of:
 - international search (under Rules 12.3 and 23.1(b))
 - publication of the international application (under Rule 12.4)
 - international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the elements* of the international application, this report is based on (replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):

Description, Pages

1-4 as originally filed

Claims, Numbers

1-14 as originally filed

Drawings, Sheets

1/1 as originally filed

a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. The amendments have resulted in the cancellation of:
 - the description, pages
 - the claims, Nos.
 - the drawings, sheets/figs
 - the sequence listing (specify):
 - any table(s) related to sequence listing (specify):
4. This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
 - the description, pages
 - the claims, Nos.
 - the drawings, sheets/figs
 - the sequence listing (specify):
 - any table(s) related to sequence listing (specify):

* If item 4 applies, some or all of these sheets may be marked "superseded."

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	5,9
	No: Claims	1-4,6-8,10-14
Inventive step (IS)	Yes: Claims	
	No: Claims	1-14
Industrial applicability (IA)	Yes: Claims	1-14
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

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Re Item V

1.1 The following document is referred to in this communication:

- D1: US-A-5 608 718 (SCHIEWE HILMAR) 4 March 1997 (1997-03-04)

1.2 The following is stated under reference to item VIII, whereby it is to be noted that unclear features cannot be used for unambiguously distinguishing over prior art in order to assess novelty or inventive step.

2. INDEPENDENT CLAIMS

2.1 CLAIM 1

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT: Document D1 discloses (the references in parentheses applying to this document) a method for the manufacture of a molded article having a specific mark on the surface thereof comprising the steps of providing a mold having a surface defining a mold cavity, said surface including a negative version of a texture (21,22) and a negative version of a specific texture (23), placing a material into the mold cavity and molding said material to define an article including a specific mark on its surface which is a positive version of the negative version of the specific texture, see col.1, line 62-col.2, line 9, and fig. 1 and 2.

The document D1 further mentions that the specific mark is visible under certain conditions, e.g. by means of an electron microscope, and is not visible under other conditions, see col. 2, lines 43-48.

2.2 CLAIM 14

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 14 is not new in the sense of Article 33(2) PCT: As seen above, D1 discloses a molded article produced by the method described in claim 1.

3. DEPENDENT CLAIMS 2-13

3.1 In view of the lack of novelty in claim 1, it is questionable whether the dependent claims 2-13 are still linked by a single general inventive concept. The application,

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hence does not necessarily meet the requirements of Rules 13.1 and 13.2 PCT.

- 3.2 As a consequence thereof, the examining instance cannot presently find a ground for the selection of one or more of the additional features as listed in claims 2-13 in order to support the presence of an inventive step. As a consequence, claims 2-13 do not meet the requirements of Article 33(3) PCT.
- 3.3 Concerning the disclosure of the additional features of claims 2-13 as such, reference is made to the international search report and the relevant passages of the cited documents in reference to the claims.
4. Claims 1-14 fulfill the requirements of Article 33(4) PCT.

Re Item VII

1. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents US-A-5608718 and US-A-5607188 is not mentioned in the description, nor are these documents identified therein.

Re Item VIII

The application does not meet the requirements of Article 6 PCT, because the claims 1, 2, 3, 13 and 14 are not clear.

1. Claim 1 relates to a method for the manufacture of an article, but the claim does not provide the reader with a technical feature to obtain visibility under certain conditions. Neither are the conditions specified. Rather, the claim refers to conditions in which the mark can be observed. If the optical characteristics of the moulded article are due to specific method steps, then these steps should be used to define the scope of the protection sought, see PCT Guidelines 5.35.
2. The expressions "*under certain conditions*", "*under other conditions*", cf. claim 1, "*at a predetermined angle*", "*at other viewing angles*", cf. claim 2, "*under a first lighting condition*" and "*under a second lighting condition*", cf. claim 3, are vague and lead the reader to doubt about the meaning of the technical features to which

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they refer, thereby rendering the definition of the subject-matter of the respective claims unclear, see PCT Guidelines 5.34.

3. Bracketed expressions, cf. claim 13, are not part of a claim's subject-matter, see PCT Guidelines 5.11. Therefore the subject-matter of claim 13 lacks clarity.
4. Claim 14 attempts to define a product by reference to the manufacturing method. Since the method itself is not clear, the product claim also lacks clarity. Moreover, the product should be defined by the features that characterize it, otherwise it is not clear whether claim 14 is a product claim or a method claim, cf. PCT Guidelines 5.26.
5. In page 4 of the description, the sentence on lines 27-29 implies that the extent of protection may be expanded in some vague and not precisely defined way, which is in contradiction with Article 6, see PCT Guidelines 5.30.